REMARKS

Claims 1-35 are all of the claims presently pending in the application. The claims have not been amended by the present Response.

Claims 25, 26, 28-32 and 34 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-2, 5-7 and 9-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumberg et al. (U.S. Publication No. 2003/0140315) (hereinafter "Blumberg") in view of Basch et al. (U.S. Patent No. 6,658,393) (hereinafter "Basch"). Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumberg in view of Basch, and further in view of Mori (U.S. Patent No. 6,089,765). Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumberg in view of Basch, and further in view of Walker et al. (U.S. Patent No. 5,970,478) (hereinafter "Walker").

These rejects are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention, of exemplary claim 1, provides a product production system for producing a product ordered by a customer including a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value (see e.g., Application at page 4, lines 21-26). This allows the claimed invention to provide a product production system capable of preventing monetary damages to shops due to customers failing to pay for services (see Application at page 2, lines 7-27).

II. THE 35 U.S.C. 112, FIRST PARAGRAPH, REJECTION

The Examiner has rejected claims 25, 26, 28-32 and 34 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner alleges that the Examiner does not provide adequate written description for the limitations "temporary stop and resumes". Applicants respectfully disagree.

First, Applicants point out that 35 U.S.C. 112, first paragraph, provides three separate and distinct requirements. These three requirements are known as the written description

requirement, the enablement requirement and the best mode requirement. These three requirements, as indicated above, are separate and distinct requirements. The Examiner's 35 U.S.C. 112 rejection is based on the enablement requirement. However, in support of his argument the Examiner alleges that there is not "adequate written description of the limitations". This is an improper form of rejection because, as indicated above, the written description requirement is separate and distinct from the enablement requirement.

Therefore, if the Examiner wishes to maintain this rejection, Applicants respectfully request the Examiner to confirm whether the 35 U.S.C. 112, first paragraph, rejection is based on lack of adequate written description or failing to comply with the written description requirement.

Second, Applicants point out that the test for enablement is whether one skilled in the relevant art would be able to make and use the invention (assuming access to common knowledge) without undue experimentation. The Examiner has failed to address this in his rejection. Therefore, the Examiner has failed to establish a *prima facie* rejection and has thus failed to meet his initial burden.

However, Applicants submit that the limitations of claims 25, 26, 28-32 and 34 are described at page 18, line 24 through page 19, line 9 of the Application in sufficient detail to allow one skilled in the relevant art, with access to common knowledge, to make and use the invention without undue experimentation.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE PRIOR ART REFERENCES

A. The Blumberg Reference

Applicants respectfully submit that Blumberg does not teach or suggest "*a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*" as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

The Examiner does not even allege that Blumberg teaches or suggests this feature. Indeed, the Examiner indicates that Blumberg "fails to teach a risk ratio calculating unit for

calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value" (see Office Action dated June 1, 2005 at page 4). Therefore, the Examiner clearly concedes that Blumberg does not teach or suggest this feature.

B. The Basch Reference

The Examiner alleges that Basch would have been combined with Blumberg to teach the claimed invention of claims 1, 2, 5-7 and 9-35. Applicants respectfully submit, however, that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination would not teach or suggest each and every feature of the claimed invention.

That is, the Examiner's alleged motivation to modify Blumberg ("to prevent providing goods and services to account holder with high risk of default and/or low credibility") is not a problem in Blumberg that would require a solution. Thus, as pointed out in MPEP §2143.01 the Examiner's motivation is "improper". That is, "*the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*" (emphasis in MPEP itself).

Along these lines, Judge Rader wrote in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

> *"In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."*

Although the holding in that case left undisturbed, under the "clear error" standard of review, the conclusion of the District Court that the prior art references were properly combinable, it specifically explained that it declined to reverse this conclusion because "... the two references address precisely the same problem ... " (emphasis by Applicants)

This aspect of the *Ruiz* holding, in which precisely the same problem is being addressed by both references, is not present in the Blumberg and Basch references used in the prior art evaluation of the present Application.

Specifically, Blumberg is directed to an on-line printing service that enables a user to interactively create and view a document prior to printing the document (see Blumberg at paragraph [0009]). The service uses a "Virtual Builder" viewer software that displays a proof of what the finished product will look like (see Blumberg at paragraph [0010]).

In stark contrast, Basch is specifically directed to a method for predicting financial risk (see Basch at Abstract). Basch is directed to minimizing financial losses to account holders (see Basch at column 3, lines 35-40). Basch has nothing at all to do with on-line printing services.

Indeed, Basch does not address the problems faced by the on-line printing service disclosed in Blumberg. Therefore, one of ordinary skill in the art would not have been motivated to modify the on-line printing service disclosed by Blumberg with the financial risk predicting method disclosed by Basch. Thus, the references would not have been combined, absent hindsight.

Moreover, neither Blumberg, nor Basch, nor any combination thereof, teaches or suggests "*a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*" as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

Indeed, as indicated above, the Examiner concedes that Blumberg does not teach or suggest this feature. The Examiner attempts to rely on Figure 1, column 6, lines 42-65 and column 18, lines 37-39 of Basch to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor these passages (nor anywhere else for that matter) does Basch teach or suggest a risk ratio calculating unit for calculating a credibility relating to

a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, Basch merely teaches a financial risk prediction system.

The claimed invention teaches calculating a credibility relating to a purchase of the product. In stark contrast, Basch merely teaches a system for predicting a financial risk based on a consumers past credit. However, the predicted risk is not calculated in specific relation to the purchase of the product made by the customer.

Thus, Basch fails to make-up for the deficiencies of Blumberg.

Furthermore, regarding claims 25-34, the Examiner merely alleges that "it would be obvious to stop producing the products for customer with credit higher risks" and "it would be obvious to resumes producing the products for customer with higher credibility and trustworthy", however, the Examiner does not provide any reference which teaches or suggest these features. Therefore, if the Examiner wishes to maintain this rejection Applicants respectfully request the Examiner to provide a reference (properly combinable with Blumberg), which specifically teaches or suggests these claimed features.

Therefore, Applicants respectfully submit that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

C. The Mori Reference

The Examiner alleges that Mori would have been combined with Blumberg and Basch to teach the claimed invention of claims 3 and 4. Applicants respectfully submit, however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, neither Mori, nor Blumberg, nor Basch, nor any combination thereof, teaches or suggests "*a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*" as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

Indeed, the Examiner attempts to rely on Figure 1 and columns 2-4 of Mori to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Mori teach or suggest a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, the Examiner does not even allege that Mori teaches or suggest this feature. The Examiner merely attempts to rely on Mori as teaching an order information storing unit that has order expiry date information defining a term to store order information.

Thus, Mori fails to make-up the deficiencies of Blumberg and Basch.

Therefore, Applicants respectfully submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

D. The Walker Reference

The Examiner alleges that Walker would have been combined with Blumberg and Basch to teach the claimed invention of claim 8. Applicants respectfully submit, however, that even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, neither Walker, nor Blumberg, nor Basch, nor any combination thereof, teaches or suggests "*a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*" as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

Indeed, the Examiner attempts to rely on Figure 1 and columns 2-4 of Walker to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Walker teach or suggest a risk ratio calculating unit for calculating a credibility relating to a purchase of the product made by the customer from information relating to the customer

associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, the Examiner does not even allege that Walker teaches or suggest this feature. The Examiner merely attempts to rely on Walker as teaching calculating a risk ratio at the time of producing the product.

Thus, Walker fails to make-up the deficiencies of Blumberg and Basch.

Therefore, Applicants respectfully submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-35, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: August 25, 2005

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